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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,813	12/07/2001	Ruggero Maria Santilli	3293.018	5659
24040	7590	06/16/2004		
MASON LAW, PL 17757 US HWY 19 N. CLEARWATER, FL 33764			EXAMINER MAYEKAR, KISHOR	
			ART UNIT 1753	PAPER NUMBER

DATE MAILED: 06/16/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/008,813

Applicant(s)

SANTILLI, RUGERRO MARIA

Examiner

Kishor Mayekar

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-60 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-60 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Specification

1. The specification is objected because the headings introducing various paragraphs of the specification have been omitted.

The following guidelines illustrate the preferred layout for the specification of a utility application. These guidelines are suggested for the applicant's use.

Arrangement of the Specification

As provided in 37 CFR 1.77(b), the specification of a utility application should include the following sections in order. Each of the lettered items should appear in upper case, without underlining or bold type, as a section heading. If no text follows the section heading, the phrase "Not Applicable" should follow the section heading:

- (a) TITLE OF THE INVENTION.
- (b) CROSS-REFERENCE TO RELATED APPLICATIONS.
- (c) STATEMENT REGARDING FEDERALLY SPONSORED RESEARCH OR DEVELOPMENT.
- (d) INCORPORATION-BY-REFERENCE OF MATERIAL SUBMITTED ON A COMPACT DISC (See 37 CFR 1.52(e)(5) and MPEP 608.05. Computer program listings (37 CFR 1.96(c)), "Sequence Listings" (37 CFR 1.821(c)), and tables having more than 50 pages of text are permitted to be submitted on compact discs.) or
REFERENCE TO A "MICROFICHE APPENDIX" (See MPEP S 608.05(a). "Microfiche Appendices" were accepted by the Office until March 1, 2001.)
- (e) BACKGROUND OF THE INVENTION.

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(1) Field of the Invention.

(2) Description of Related Art including information disclosed under 37 CFR 1.97 and 1.98.

(f) BRIEF SUMMARY OF THE INVENTION.

(g) BRIEF DESCRIPTION OF THE SEVERAL VIEWS OF THE DRAWING(S).

(h) DETAILED DESCRIPTION OF THE INVENTION.

(i) CLAIM OR CLAIMS (commencing on a separate sheet).

(j) ABSTRACT OF THE DISCLOSURE (commencing on a separate sheet).

(k) SEQUENCE LISTING (See MPEP § 2424 and 37 CFR 1.821-1.825. A

"Sequence Listing" is required on paper if the application discloses a nucleotide or amino acid sequence as defined in 37 CFR 1.821(a) and if the required "Sequence Listing" is not submitted as an electronic document on compact disc).

2. The specification is objected to as failing to provide proper meaning, a meaning comprehended to one skill in the art, of the term "magnegas" throughout. Correction of the following is required.

3. Claims 13, 14, 42 and 43 are objected to because of the term "so as" that needs to be deleted. Appropriate correction is required.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

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The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

5. Claims 1-60 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the forming of an electric arc between electrodes, does not reasonably provide enablement for the forming of an electric arc between electrodes and copper holders. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention commensurate in scope with these claims

6. Claims 1-60 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Claims 1, 19, 29, 30, 48 and 60 recite the term "magnegas", however the term is not comprehended to one of the skill in the art.

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7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 1-60 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term "clean burning magnegas" in claims 1, 19, 29, 30, 48 and 60 is used by the claim to mean "clean burning gas", while the accepted meaning is "clean burning combustible gas." The term is indefinite because the specification does not clearly redefine the term.

Regarding claim 1, the phrase "being essentially filled" needs to be amended as --adapted to be filled-- to eliminate reference to a method of operating the

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apparatus. The phrase "minimizes a distance between an electric arc between the electrodes and said copper holders" is confusing.

Regarding claim 11, the phrase "is negatively charged needs to be amended for example in the format as --is adapted to be negatively charged-- to eliminate reference to a method of operating the apparatus.

Regarding claim 12, the phrases "is positively charged", "submerged" (two occurrences), and "filling up" need to be amended for example in the format as --is adapted to be positively charged-- to eliminate reference to a method of operating the apparatus.

Regarding claim 13, the same is applied to claim 12.

Regarding claim 14, the same is applied to claim 12.

Regarding claim 15, the same is applied to claim 12.

Regarding claim 16, the same is applied to claim 12 to the phrases "submerged" and "filling up".

Regarding claim 17, the same is applied to claim 12 to the phrase "submerged".

Regarding claim 13, the same is applied similar to claim 12 to the phrase "penetrates".

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Regarding claim 29, the same is applied to claim 1.

Regarding claim 30, the same is applied to claim 1 to the phrase "a distance ... copper holders".

Regarding claim 41, the use of the term "suitable" in a claim process renders the claim indefinite as whether the action following the term is not positively recited.

Regarding claim 42, the same is applied to claim 41.

Regarding claim 43, the same is applied to claim 41.

Regarding claim 44, the same is applied to claim 41.

Regarding claim 45, the same is applied to claim 41.

Regarding claim 46, the same is applied to claim 41.

Regarding claim 60, the same is applied to claim 30.

Double Patenting

9. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214

USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

10. Claims 1-18, 20-47 and 49-60 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1, 2, 7, 8, 10- 12, 14-17, 26, 35, 36 38, 44-47, 51-53, 61 and 62 of U.S. Patent No. 6,540,966. Although the conflicting claims are not identical, they are not patentably distinct from each other because the patent claims recite all the structures and steps as claimed except for the provision of means for automatically refilling or the step of providing means for automatically refilling. The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the patent claims' teachings because the provision of mechanical means or automatic means to replace manual activity has been held to be obvious, *In re Venner* 120 USPQ 192.

As to the subject matter of claim 11 and 40, the selection of any of known equivalent electrode material would have been within the level of ordinary skill in the art.

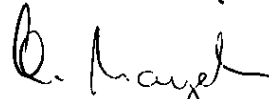
11. Claims 19 and 48 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-18, 20-47 and 49-60 of U.S. Patent No. 6,540,966 in view of Pub. No. 20030113597. The difference between the patent claims as applied above and the instant claims is the provision or step of means for circulating a portion of the produced gas. The claims 1 and 33 of the corresponding US application recites the above limitation. The subject matter as a whole would have been obvious to one having ordinary skill in the art at the time the invention was made to have modified the patent claims' teachings as suggested in claims 1 and 33 because this would result in circulating of the gas produced.

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kishor Mayekar whose telephone number is (571) 272-1339. The examiner can normally be reached on Monday-Thursday.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nam Nguyen can be reached on (571) 272-1342. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Kishor Mayekar
Primary Examiner
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